

Due Date: October 14, 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Gregory A. Roy et al.	Examiner:	Phu K. Nguyen
Serial No.:	10/642,857	Group Art Unit:	2628
Filed:	August 18, 2003	Docket:	G&C 30566.17-US-C3
Title:	VECTOR-BASED GEOGRAPHIC DATA		

PRE-APPEAL BRIEF REQUEST FOR REVIEW ARGUMENTS

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the final Office Action dated July 14, 2006, Applicants hereby submit a Notice of Appeal accompanied by a Pre-Appeal Brief Request for Review. The claims have not been amended. Appellants submit that based on the claims and cited art, there are clear errors in the examiner's rejections and further, the rejections fail to establish essential elements needed for a prima facie rejection.

Failure to Establish Prima Facie Case under 35 U.S.C. §103(a)

Appellants directs the panel to pages 8-13 of the Request for Reconsideration filed by Appellant on April 24, 2006 for the substance of the arguments. Based on such arguments, Appellants submit that there is clear error in the examiner's rejection. Such failures are more clearly set forth below.

Map File that Provides a URL that Identifies a Storage Location of Vector Based Map Data

Appellant directs the Panel to pages 9-10 and 11-12 of the Request for Reconsideration filed by Appellant on April 24, 2006 for the substance of the arguments.

In response to the arguments, the final Office Action merely states:

(1) Goodenough, Drutman, and Alexander do not teach, disclose, or suggests a map file that provides a uniform resource locator.

Uniform Resource Identifiers (URLs, aka URLs) are short strings that identify resources in the web: documents, images, downloadable files, services, electronic mailboxes, and other resources. They make resources available under a variety of naming schemes and access methods such as HTTP, FTP, and Internet mail addressable in the same simple way. They reduce the tedium of "log in to this server, then issue this magic command ..." down to a single click. Applicant's application refers to the display a map in which the map objects' information is a vector based map data which is provided through sources in the web using URLs. Goodenough teaches a map with its objects (Goodenough, the data from the thematic mapper is obtained to satisfy the request for the map showing the forest depletion over past 20 years; page 1203, column 1, lines 11-12); Drutman specifically teaches Goodenough's objects is vector based map data (Drutman, representation of feature attribute; Table II, page III-529); and Alexander teaches the map data is accessed through Internet which is addressed through Uniform Source Locator (Alexander, a map database is stored as a bit map or as vectors that point to a map character in a memory storage device which is remotely accessed through Internet using USLs; column 5, lines 57-65).

(2) Goodenough, Drutman, and Alexander do not teach, disclose, or suggests a map file that provides a uniform resource locator that identifies a storage of vector based map data.

Alexander teaches the map data is accessed through Internet as showed above (column 5, lines 57-65). It is a standard access of data in Internet using USL. Uniform Resource Identifiers (URLs, aka URLs), by definition, are short strings that identify resources in the web: documents, images, downloadable files, services, electronic mailboxes, and other resources. They make resources available under a variety of naming schemes and access methods such as HTTP, FTP, and Internet mail addressable in the same simple way. Alexander, clearly states that "a map database is stored as a bit map or as vectors that point to a map character in a memory storage device" (column 1, lines 26-28); and the memory storage is remotely accessed through Internet's locations (column 5, lines 57-65). It is clearly the combination of Goodenough, Drutman, and Alexander teaches a map file that provides a uniform resource locator that identifies a storage of vector based map data.

Appellant respectfully traverses the above assertions. Firstly, in the Office Action, the Patent Office acknowledges the lack of teaching in Capps of the prioritized pool. However, now the Office Action is relying on Capps. Appellants note that nowhere in the cited text, the first Office Action, or the final Office Action, is there any description or mention of a prioritized pool of geometric entities. Similarly, the neither the first Office Action nor the final Office Action mention or even remotely reference the prioritization of a particular geometric entity within such a pool. Instead, the Office Action merely disregards and ignores this explicit claim limitation. The disregard of a particular claim limitation establishes clear error in the rejection and omits an essential element needed to establish a prima facie rejection.

The Action further relies on Alexander to teach the claimed elements. Firstly, Appellants direct the attention of the panel to the argument below regarding the validity of Alexander as a reference. Secondly, Appellants note that while the Office Action states that Alexander asserts memory storage can be remotely accessed through Internet locations (citing col. 5, lines 57-65), the cited text does not mention or describe the Internet whatsoever. Accordingly, the Office Action is

misinterpreting Alexander. Lastly, the Office Action equates a map database that is stored as a bitmap or vectors that point to a map character as equivalent to the claimed map file that contains URLs that identifies a storage location of vector based map data. Such an equivalency is meritless. In this regard, Alexander's pointer to map characters are not remotely similar to (nor to they suggest or even hint at) a URL that identifies a storage location for vector based map data (as claimed).

Accordingly, Appellants submit the Office Action is clearly in error and has various omissions that fail to establish a *prima facie* case of obviousness.

Ability to Determine Storage Location of Vector Map Data that Defines a Map Object for a Requested Map Picture

Appellants direct the attention of the panel to pages 9-10 of the Request for Reconsideration filed by Appellant on April 24, 2006 for the substance of the arguments.

In response to earlier arguments, the Office Action provides:

(3) Goodenounh, Drutman, and Alexander do not teach, disclose, or suggests the ability to determine a storage location of vector map data that defines a map object for a requested map picture.

All of the cited references teach the representation of a map on a screen in which the map picture is vector based data [Drutman, representation of feature/attribute; Table II, page 111-529; Alexander, column 1, lines 26-28). To display the map, the systems must have ability to determine where is the displayed information located, or the storage location of map data. It is clear that the cited references have "the ability to determine a storage location of vector map data that defines a map object for a requested map picture."

Appellants again traverse such assertions and note that instead of specifying where the references teach a storage location or a URL that identifies such a storage location, the references state that the references teach a map picture having vector based data and then concludes that the references must have ability to determine where information is located and therefore it is clear that the ability to determine the storage location is within the cited reference teachings. Such a conclusory based rejection without any support in the references is clearly an error. Under MPEP §2142 and 2143.03 "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." In this regard, to summarily conclude that a claim element is obvious without any support for such a conclusion is wholly without merit. In view of the above, Appellants submit that the rejection is

clearly in error and contains various omissions of essential elements that are needed for a prima facie rejection.

Lack of Motivation to Combine the References

Appellants direct the attention of the panel to page 13 of the Request for Reconsideration filed by Appellant on April 24, 2006 for the substance of the arguments. In response, the final Office Action asserts:

(5) There is no motivation to combine the cited references.

The modification of the Goodenough's teach to configure the claimed invention is implemented by storing the map representing the area's features in a vector format (Drutman, page 111-528, column 2, lines 28-30) in a location in memory identifiable by its URLs for communicating in World Wide Web (Alexander, connection of the system to Internet, column 12, lines 29-33). The motivation for storing the map representing the objects in a vector format in a location in memory identifiable by its URLs is the simplicity of map file with its vector-based objects communicated through their URLs and the richness of resource provided in the Internet (Alexander, column 5, lines 57-65).

Appellants again direct the attention of the panel to the arguments below regarding the validity of Alexander as a reference. Again, there is not motivation within the references that does not rely on impermissible hindsight provided by the teaching of the present invention.

Alexander is Not a Valid Reference

Appellants direct the attention of the panel to pages 11-12 of the Request for Reconsideration filed by Appellant on April 24, 2006 for the substance of the arguments. In response, the Office Action asserts:

(6) Alexander is not a valid reference with respect to the present invention.

Alexander claims benefit of its filing date through its provisional application 601025,528 which has its filing date September 6, 1996 predated the present application effective filing date (October 30, 1996). In its provisional application, Alexander teaches the vector map data (page 1, line 17-18), access data through Internet (page 6, lines 19-20; page 7, lines 5-7). Examiner attaches a copy of the US provisional application serial number 601025,528.

Appellants first note that a partial copy of the provisional application was received with the Office Action. However, numerous pages were missing as can be seen in IFW (including pages 5, 8, and 9). It is unknown if other material is missing. Appellants (via Jason S. Feldmar, Reg. No. 39,187) conducted a teleconference with Examiner Nguyen on July 27, 2006. The Examiner agreed to provide an additional copy of the provisional in the form of a supplemental Office Action. To date, no copy has been received.

The response asserts that Alexander, lines 19-20 and page 7, lines 5-7 teaches the access of data through the Internet. Appellant respectfully disagrees. Such text does not refer to nor reference, explicitly or implicitly, the Internet. In addition, Appellants note that the Office Action relies on Alexander col. 5, lines 57-65 in numerous parts of the rejection. This portion of text refers to Alexander Fig. 17. Appellants note that neither Figure 17, nor the text of col. 5, lines 57-65 appear anywhere in Alexander's provisional application. Again, to rely on a provisional filing date to beat the date of the present invention, two conditions must be satisfied: (1) the subject matter of the claim in the issued patent must be supported in accordance with 35 U.S.C 112, first paragraph, in the earlier filed application, and (2) the subject matter used in the rejection must be disclosed in the earlier-filed application in compliance with 35 U.S.C. 112, first paragraph, in order for that subject matter to be entitled to the earlier filing date under 35 U.S.C. 102(e). (See MPEP 201.11 and MPEP 706.02(f)(1); *Tronzio v. Biomet, Inc.*, 156 F.3d 1154, 47 USPQ2d 1829 (Fed. Cir. 1998); *In re Scheiber*, 587 F.2d 59, 199 USPQ 782 (CCPA 1978); *Studiengesellschaft Kohle m.b.H. v. Shell Oil Co.*, 112 F.3d 1561, 1564, 42 USPQ2d 1674, 1677 (Fed. Cir. 1997); and *New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1294, 63 USPQ2d 1843, 1846 (Fed. Cir. 2002)). These elements have not been established in the Office Action at all. Further, the lack of existence of relied upon portions in the provisional application is clearly an error in the rejection. In view of the above, the reliance on Alexander's provisional application filing date is improper and meritless.

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicant's undersigned attorney.

Respectfully submitted,

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Date: September 15, 2006

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